REMARKS

The outstanding Office Action Restriction Requirement ("Office Action") mailed on November 3, 2004 requires that Applicants elect one of the following six (6) allegedly distinct inventions:

I. Claims 25-29 (in part), drawn to a compound for having formula R-SO_n-Z-CO-Y wherein Y is -NH_2, classified variously, for example, in class 568, subclasses 27, 28 and 31 depending on the structure.

II. Claims 25-29 (in part), drawn to a compound for having formula R-SO_n-Z-CO-Y wherein Y is -O-CH_2-C_6H_5, classified variously, for example, in class 514, subclass 601 depending on the structure.

III. Claims 25-29 (in part), drawn to a compound for having formula R-SO_n-Z-CO-Y wherein Y is -CO-CO-O-CH_3, classified variously, for example, in class 514, subclasses 546 and 550 and class 560, subclasses 149-150 depending on the structure.

IV. Claims 30-48 (in part), drawn to a method for treating an animal with a microbial-based infection using a compound for having formula R-SO_n-Z-CO-Y wherein Y is -NH_2, classified variously, for example, in class 568, subclasses 27, 28 and 31 depending on the structure.

V. Claims 30-48 (in part), drawn to a method for treating an animal with a microbial-based infection using a compound for having formula R-SO_n-Z-CO-Y wherein Y is -O-CH_2-C_6H_5, classified variously, for example, in class 514, subclass 601 depending on the structure.

VI. Claims 30-48 (in part), drawn to a method for treating an animal with a microbial-based infection using a compound for having formula R-SO_n-Z-CO-Y wherein Y is -CO-CO-O-CH_3, classified variously, for example, in class 514, subclasses 546 and 550 and class 560, subclasses 149-150 depending on the structure.

The Office Action further required, if Applicants elect the invention of Group IV-VI, to elect from the following allegedly patentably distinct species:

Subgroup 1: Species of compound shown in formula (e.g. see claim 30).

Subgroup 2: Species of microbe (e.g., see claim 44).

Subgroup 3: Species of animal (e.g., see claim 48).

Applicants herewith elect, with traverse, Group IV, which covers claims 30-48 (in part),

drawn to a method for treating an animal with a microbial-based infection using a compound having the formula R-SO_n-Z-CO-Y wherein Y is -NH_2, and respectfully requests reconsideration of the restriction requirement in view of the following remarks. Applicants submit that Group IV further covers a method for treating an animal with a microbial-based infection using a compound having formula R-SO_n-Z-CO-Y wherein Y is -O-CH_3, as such subject matter was not separately identified in the Office Action.

Applicants elect, with traverse, the species of compound where R is $C_{10}H_{21}$, Z is -CH_2-, Y is -NH_2 and n is 2. Applicants elect, with traverse, the species of microbe directed to *Mycobacteria tuberculosis*. Applicants elect, with traverse, the species of animal directed to a human.

Traverse of Restriction Requirement

Applicants respectfully urge that the Restriction Requirement is improper, as it does not establish that searching all the inventions would constitute an undue burden on the Patent Office. Accordingly, Applicants submit that the Restriction Requirement is improper and should be withdrawn or at least modified.

According to the MPEP, when claims can be examined together without undue burden, the U.S. Patent and Trademark Office ("USPTO") must examine the claims on the merits even though they are directed to independent and distinct inventions. *See* MPEP at § 803.01. In establishing that an "undue burden" would exist for co-examination of claims, the USPTO must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. To show undue burden resulting from searching difficulties, the USPTO must show that the restricted groups have a separate classification, acquired a separate status in the art, or that searching would require different fields of search. *See* MPEP at § 808.02.

Applicants submit that it would not constitute an undue burden to examine the inventions of Groups IV-VI together. The inventions of Groups IV-VI, while patentably distinct from each other, are related to each other by subject matter. Indeed, in the parent application, U.S. Appl. No. 09/486,550 ("the '550 parent application"), groups analogous to Groups IV-VI were

recombined and examined together. In the '550 parent application, claims 1-3 were drawn to compounds of the formula R-SO_n-Z-CO-Y and were restricted among Groups I-III. *See* the '550 parent application, Office Action of July 15, 2002, page 3. Group II, claims 1-3 (in part), was drawn to compounds of the formula R-SO_n-Z-CO-Y wherein Y was NH_2. *See id.* Applicants' election included Group II in the '550 parent application. *See id.* However, Groups I-III in the '550 parent application were subsequently recombined. *See* the '550 application, Office Action of October 2, 2002, page 3 (citing MPEP § 803.02).

Hence, claims 1-3, which included compounds of the formula R-SO_n-Z-CO-Y wherein Y was selected from -NH_2, -O-CH_2-C_6H_5, -CO-CO-O-CH_3, and O-CH_3, were examined together on the merits in the parent application. *See id.* Accordingly, in the instant application, it would not constitute an undue burden to search Groups IV-VI, which are directed to methods using compounds of the formula R-SO_n-Z-CO-Y wherein Y is -NH_2 (Group IV), -O-CH_2-C_6H_5 (Group V), and -CO-CO-O-CH_3 (Group VI). Indeed, the compounds encompassed by the subject matter of Groups IV-VI have already been examined together in the '550 parent application. Thus, it would not constitute an undue burden to search the methods directed to using these compounds. Hence, the instant restriction of such methods on the basis of these compounds that have already been searched and examined together should be withdrawn. Consequently, Applicants submit that, similar to the examination of claims 1-3 in the parent application, claims 30-48 of the instant application should be examined together on the merits.

In view of the above remarks, it is respectfully requested that the restriction requirement be reconsidered, that Groups IV-VI be recombined, and that all of claims 30-48 be allowed to be prosecuted in the same patent application.

Species Election

Under Subgroup 1, Applicants elect the species of compound where R is $C_{10}H_{21}$, Z is -CH_2-, Y is -NH_2 and n is 2, with traverse. The claims that cover the species of the compound where R is C_8H_{17}, Z is -CH_2-, Y is -NH_2 and n is 2 are claims 30, 32, 34, 36-38, 41-42, and 44-48.

Under Subgroup 2, Applicants elect the species of microbe directed to *Mycobacteria tuberculosis*, with traverse. The claims that cover the species of microbe directed to *Mycobacteria tuberculosis* are claims 30-48.

Under Subgroup 3, Applicants provisionally elect the species of animal directed to a human. The claims that cover the species of animal directed to a human are claims 30-45 and 48.

Applicants submit that it would not constitute an undue burden to examine the species within each of the Subgroups together. The species within each of the Subgroups, while patentably distinct, are closely related to each other by subject matter. As discussed above, groups analogous to the species of Subgroup I were examined together, as claims 1-3 of the '550 parent application, which covered the various species within Subgroup I, were examined together on the merits. Furthermore, the species within Subgroup II and Subgroup III are closely related as they fall within methods of treating an animal with a microbially-based infection comprising administering an effective amount of a compound. Consequently, Applicants submit that it would not constitute an undue burden to search all species within each Subgroup. In any case, upon a finding that the elected species is novel, Applicants respectfully request that all of claims 30-48 be examined on the merits.

In view of the above remarks, it is respectfully requested that the species election be withdrawn and that all claims be allowed to be prosecuted in the same patent application.

CONCLUSION

Applicants maintain that the restriction requirement and species election are improper and that all pending claims, *i.e.*, claims 25-48, should be examined for patentability. If the Examiner believes that the prosecution might be advanced by discussing the application with Applicants' representatives, in person or over the telephone, we would welcome the opportunity to do so.

Respectfully submitted,

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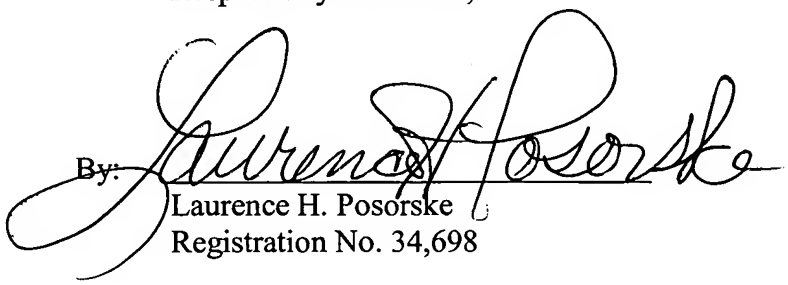
By: 
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